

REMARKS

Claim 1 is amended herein. Claims 1-2, 5-17, 20-26 and 29-35 remain pending in the present application. No new matter has been added as a result of the Claim amendments.

101 Rejections

According to the final rejection, Claims 1-2, 5-17, 20-26 and 29-35 are rejected under 35 U.S.C. § 101 because the invention is directed to nonstatutory subject matter.

In *In Re Lowry* (32 F.3d 1579, 32 U.S.P.Q. 2d 1031; Fed. Cir. 1994), the Federal Circuit ruled that an “electronic structure,” constructed as a memory containing information stored in a particular arrangement, can serve as the basis for a patentable invention. The Federal Circuit determined that the claimed data structure was a physical entity having specific electrical or magnetic elements in memory. The court considered that the Lowry data structure imposed a physical organization on the data, and found that stored data existing as a collection of bits having information about data relationships may constitute patentable subject matter. Lowry asserted that a memory containing data organized by the claimed data structure permits a computer to efficiently access and to use the stored data, and thus the data structure had tangible benefits.

Applicants respectfully assert that a review of the claims of the instant application against an issued data structure claim of the Lowry patent (e.g., Claim 1 of U.S. Patent No. 5,664,177) demonstrates that the claims of the instant application are statutory.

Also, according to MPEP § 2106.01 (the Eighth Edition Incorporating Revision No. 5), “[d]escriptive material can be characterized as either ‘functional descriptive material’ or ‘nonfunctional descriptive material.’ In this context,

'functional descriptive material' consists of data structures and computer programs which impart functionality when employed as a computer component. (The definition of 'data structure' is 'a physical or logical relationship among data elements, designed to support specific data manipulation functions.')

... When functional descriptive material is recorded on some computer-readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized."

Furthermore, according to Section I of MPEP § 2106.01 "a claimed computer-readable medium encoded with a data structure defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure's functionality to be realized, and is thus statutory" (emphasis added).

Currently amended Independent Claim 1 recites "[a] computer implemented method for defining an optimal end of product life integrated action plan for procurement, manufacturing, and marketing." Independent Claim 12 recites "[a] computer system comprising: a bus; a memory unit coupled to said bus; and a processor coupled to said bus, said processor for executing a method for defining an optimal end of product life integrated action plan for procurement, manufacturing, and marketing." Independent Claims 25 recites "[a] computer-usable medium having computer-readable program code embodied therein for causing a computer system to perform a method for defining an optimal end of product life integrated action plan for procurement, manufacturing, and marketing." Claim 25 also recites "evaluating said end of product life materials planning parameters and said end of product life pricing parameters in conjunction to define said integrated action plan, wherein said integrated action plan is an end of product life integrated action plan" (emphasis added).

In view of *In Re Lowry*, the example provided by the issued Lowry patent, and the guidance provided by the MPEP, Applicants respectfully submit that independent Claims 1, 12 and 25 are directed to patentable subject matter, and as such their dependent Claims 2, 5-11, 13-17, 20-24, 26 and 29-35 are also directed to patentable subject matter. Accordingly, Applicants respectfully submit that an essential element needed for a *prima facie* rejection of Claims 1-2, 5-17, 20-26 and 29-35 is missing, and respectfully request review of the 35 U.S.C. §101 rejection of these claims.

Rejection under 103(a)

Claims 1-2, 5-17, 20-26 and 29-35

In the Office Action, the Examiner rejected Claims 1-2, 5-17, 20-26 and 29-35 under 35 USC 103(a) as being unpatentable over Huang et al. (6151582) in view of Santos et al. (20020143665). Applicants have reviewed the cited reference and respectfully submit that the present invention is not rendered obvious over Huang et al. in view of Santos et al. for the following rationale.

Applicants respectfully submit that currently amended Claim 1 (Claims 12 and 25 include similar features) includes the feature "defining an optimal end of product life integrated action plan for procurement, manufacturing, and marketing comprising:

- a) accessing end of product life materials planning parameters;
- b) accessing end of product life pricing parameters; and
- c) evaluating said end of product life materials planning parameters and said end of product life pricing parameters in conjunction to define said integrated action plan, wherein said integrated action plan is an end of product life integrated action plan." Support for the Claimed feature can be found throughout the Specification including page 8 lines 1-31.

Applicants have reviewed Huang et al. and agree with the Examiner that Huang et al. fails to explicitly teach a system that accounts for end of product life situations.

However, Applicants respectfully submit that the present invention is not rendered obvious over Huang et al. in view of Santos et al. for the following rationale.

According to MPEP 706.02(I)(1)

***>Enacted on< November 29, 1999, >the American Inventors Protection Act (AIPA) added< subject matter which was prior art under former 35 U.S.C. 103 via 35 U.S.C. 102(e) **>as< disqualified * prior art against the claimed invention if that subject matter and the claimed invention “were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.” *>The 1999< change to 35 U.S.C. 103(c) *>only applied< to all utility, design and plant patent applications filed on or after November 29, 1999**>.**

Applicant respectfully submits that the Present Application 10/023,960 and US Patent Publication 20020143665 (Santos et al.) were, at the time the invention of Application 10/023,960 was made, commonly owned by or subject to an obligation of assignment to Hewlett-Packard Company. Moreover, Santos et al. would be prior art under former 35 U.S.C. 103 via 35 U.S.C. §102(e).

Thus, Applicants respectfully submits that Santos et al. is disqualified as prior art. Thus, the rejection of Claims 1-2, 5-17, 20-26 and 29-35 under 35 U.S.C. §103(a) with regard to Santos et al. is moot.

Therefore, Applicant respectfully submits that the shortcomings of Huang et al. as stated by the Examiner on page 5 of the Office Action with regard to Claims 1, 12 and 25 clearly provide the allowability of Claims 1, 12 and 25.

For this reason, Applicants respectfully state that Claims 1, 12 and 25 are not taught or rendered obvious over Huang et al. in view of Santos et al. As such, Applicants respectfully submit that Claims 1, 12 and 25 overcome the rejection under 35 U.S.C. §103 (a) and that Claims 1, 12 and 25 are allowable.

With respect to Claims 2 and 5-11, Applicants respectfully state that Claims 2 and 5-11 depend from the allowable Independent Claim 1 and recite further features of the present claimed invention. With respect to Claims 12-17 and 20-24, Applicants respectfully point out that Claims 12-17 and 20-24 depend from the allowable Independent Claim 12 and recite further features of the present claimed invention. With respect to Claims 26 and 29-35, Applicants respectfully point out that Claims 26 and 29-35 depend from the allowable Independent Claim 25 and recite further features of the present claimed invention. Therefore, Applicants respectfully state that Claims 2, 5-11, 13-17, 20-24, 26 and 29-35 are allowable as pending from allowable base Claims.

CONCLUSION

Based on the arguments presented above, Applicants respectfully assert that Claims 1-2, 5-17, 20-26 and 29-35 overcome the rejections of record, and therefore, Applicants respectfully solicit allowance of these Claims.

The Examiner is invited to contact Applicants' undersigned representative if the Examiner believes such action would expedite resolution of the present Application.

Respectfully submitted,
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